

REMARKS

INTRODUCTION:

In accordance with the foregoing, no claims have been canceled or amended. New claim 22 has been added and finds support at least at paragraphs [0015] and [0016] of the present application. Accordingly, no new matter is being presented, and approval and entry are respectfully requested.

Claims 1-22 are pending and under consideration. Reconsideration is respectfully requested.

REQUEST FOR INTERVIEW BEFORE OFFICE ACTION:

Applicants respectfully request the Examiner contact the undersigned attorney to discuss the pending claims before issuance of an Office Action.

Applicants believe that a more thorough review of the underlying references and the pending claims will be helpful to further prosecution.

REJECTION UNDER 35 U.S.C. §101:

Claims 9-11 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. At least for the reasons herein, the rejection is traversed and reconsideration is respectfully requested.

The Office Action asserts at page 3, item 3 that:

"The claim...is rejected for leading to non-statutory subject matter."

Claims 9-11 are directed to an "apparatus installing a device driver to drive a device that performs a predetermined function" i.e. the apparatus identified in the Office Action. Claims 9-11 are thus submitted to fit specifically within one or another of the "machine" or "manufacture" categories of statutory subject matter under 35 U.S.C. § 101. As provided therein:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Since claims 9-11 fall within one of the four stated categories of statutory subject matter, claims 9-11 are submitted to be directed to statutory subject matter within the meaning of 35 U.S.C. § 101.

The Office Action asserts further at page 3, item 3 that:

"Comprising solely of software entities without any such tangible support or hardware/executing engine to carry the functionality of these software entities, the claimed invention is not reasonably perceived as able to yield a tangible result.

To the contrary, Fig. 4 of the specification, for example, is a block diagram showing a functional structure to support the claimed invention, which is implemented by the program control of a computer device, as described in at least paragraph [0024].

Furthermore, the described "first driver installation unit" and "second driver installation unit" are submitted to be substantially synonymous with any software installation device, which is familiar to those of skill in the art as an example of hardware, software, or a combination thereof.

The Office Action asserts further at page 3, item 3 that the "claim hence fails to fulfill the Practical Application Test as set forth above."

According to the Guidelines, however, an inquiry as to whether a claim has a practical application is only necessary for claims that include *excluded* subject matter, such as an abstract idea, a law of nature, or a natural phenomenon. In particular, as provided in the Guidelines at page 19, lines 1-9:

For claims including such excluded subject matter to be eligible, the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon. *Diehr*, 450 U.S. at 187, 209 USPQ at 8 ("application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection."); *Benson*, 409 U.S. at 71, 175 USPQ at 676 (rejecting formula claim because it "has no substantial practical application").

Thus, the "practical application," consideration is meant to determine whether a claim that includes excluded subject matter is *nevertheless* directed to statutory subject matter, since the claim is for a practical application of the excluded matter. However, as Applicants have previously asserted in at least two prior Office Action responses, there is no assertion in the Office Actions that any of claims 9-11 include an abstract idea, a law of nature, or a natural phenomenon in the first place, so requiring them to be directed to a practical application is at least premature, as well as inapposite.

Applicants remind the Examiner that, as noted in at least MPEP 706.07(f), the Examiner is required to answer and address all traversals. This requirement is in addition to any repetition of a previously held position and is required to allow the applicant a chance to review the Examiner's position as to these arguments and to clarify the record for appeal.

Thus, the “practical application,” consideration is only meant to apply to claims that include excluded subject matter, and thus fall into one of the § 101 judicial exceptions. To read otherwise would be to read the Guidelines as *requiring* claims to include excluded subject matter, so that they can be salvaged by also reciting a practical application. Since, as discussed above, none of claims 9-11 includes excluded subject matter in the first place, there is no further requirement that they be directed to a practical application.

According to the Guidelines, furthermore, USPTO personnel must *first* identify whether the claim falls within at least one of the four enumerated categories of patentable subject matter recited in 35 U.S.C. § 101. In particular, as provided in the Guidelines at page 14, lines 20, 21, and 22, continuing at page 15, lines 1 and 2:

To properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. § 101, USPTO personnel must first identify whether the claim falls within at least one of the four enumerated categories of patentable subject matter recited in section 101 (process, machine, manufacture or composition of matter).

Since claims 9-11 fall within at least the “machine” or the “manufacture” categories, claims 9-11 are submitted to be directed to statutory subject matter within the meaning of 35 U.S.C. § 101.

Additionally, as provided in the Guidelines, the burden is on the USPTO to set forth a prima facie case of unpatentability. Thus, claims are presumed to belong to one of the four enumerated categories of patentable subject matter recited in 35 U.S.C. § 101 unless the Office is able to show otherwise. In particular, as provided in the Guidelines at page 16, lines 1-4:

The burden is on the USPTO to set forth a prima facie case of unpatentability. Therefore if the examiner determines that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, the examiner must provide an explanation.

Since the Office Action includes no assertion that claims 9-11 do *not* fall within at least the “machine” or the “manufacture” categories, the Office has set forth no prima facie case of unpatentability, and claims 9-11 are submitted to be directed to statutory subject matter within the meaning of 35 U.S.C. § 101.

Furthermore, according to the Guidelines, an examiner must ascertain the scope of the claim to determine whether it covers either a § 101 judicial exception or a practical application of a § 101 judicial exception. In particular, as provided in the Guidelines at page 18, lines 6-13:

An examiner must ascertain the scope of the claim to determine whether it covers either a § 101 judicial exception or a practical application of a § 101 judicial exception. The conclusion that a particular claim includes a § 101 judicial exception does not end the inquiry because “[i]t is now commonplace that an

application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.” *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (emphasis in original); accord *Flook*, 437 U.S. at 590, 198 USPQ at 197; *Benson*, 409 U.S. at 67, 175 USPQ at 675.).

Since, as discussed above, none of claims 9-11 contain any of the three § 101 judicial exceptions to patentable subject matter, i.e an abstract idea, a law of nature, or a natural phenomenon, in the first place, they necessarily recite more than a § 101 judicial exception. Claims 9-11 are thus submitted to be directed to statutory subject matter within the meaning of 35 U.S.C. § 101.

Accordingly, claims 9-11 are submitted to be allowable and withdrawal of the rejection is earnestly solicited.

REJECTION UNDER 35 U.S.C. §102:

Claims 1-4, 9-10, 12-15, and 17-21 stand rejected under 35 U.S.C. §102(a) in view of "Installing the Intel Pro/Wireless 2011 LAN PC Card in Windows 2000 Professional" *WinBook Tech Article* – article no.: WBTA09000774 ("IntelWBTA"). At least for the reasons set forth herein, this rejection is traversed and reconsideration is respectfully requested.

Claim 1 recites at least:

“copying and storing the device driver *file*.”

The current rejection is based on the assertion that “[I]t is very hard to disassociate the process of installing and that of copying in terms of two unrelated actions that would not depend on one another.” *Office Action*, page 12, lines 13-14. Applicants do not disagree with this assertion herein.

However, Applicants believe the Examiner is misinterpreting the distinction between a “device driver” and a “device driver file,” as used in the present application.

IntelWBTA, at steps 4-10 starting on page 3, describes the installation of a **device driver** for a wireless PC card. For example, several steps including 5 and 8 refer to the downloading of the “driver.” Per the Examiner’s previous argument, the installation described in IntelWBTA is equivalent to the copying and storing of a **device driver**.

However, this is not the same as the “copying and storing the device driver *file*” as recited in at least claim 1. In fact, the process outlined in IntelWBTA, is substantially similar to that described in the *Description of the Related Art* section of the present application. As a non-limiting example only, paragraph [0003] of the present application describes a conventional method of installing a device driver as follows:

In a conventional method of installing a device driver, for example, a printer driver, when a user inserts a compact disk (CD) including a printer driver file into a computer, a driver installation start image is automatically displayed on a monitor of the computer. Here, if the user presses an installation start button, which issues a command to install a driver, via the driver installation start image, the computer operates (executes) a setup file of the printer driver and installs the printer driver stored on the CD in the computer. In this case, when necessary, the user may re-boot the computer, i.e., initialize the computer again, to complete the installation of the printer driver.

As described in the *Description of the Related Art*, IntelWBTA uses a CD (step 1) and a driver installation start image is automatically displayed (the window of step 2). The user then presses an installation start button (step 7), which issues a command to install a driver and the computer executes a setup file of the printer driver and installs the **printer driver** stored on the CD in the computer(step 8).

In contrast, and by way of review only, the present application describes the copying and storing of a device driver *file* in paragraph [0016] which states.

At operation 36, the device driver file, which is provided from the outside and installed at operation 34, is also copied and stored in the computer, for example, in a hard disk drive (HDD) of the computer. At operation 38, after installation of the device driver, an icon for re-installation of the device driver is generated. Typically, the icon for re-installation of the device driver is connected to the installation program, such as the "setup.exe" file, for the device driver. Accordingly, at operation 38, when the icon for re-installation of the device driver is selected, the "setup.exe" file for the device driver is executed to re-install the device driver from the stored device driver file in the computer, thereby advantageously allowing the user to re-install the device driver as desired, for example, in the case of an error during the previous installation session, etc. In particular, at operation 38, the user may reinstall the device driver without accessing the outside (external to the computer) machine-readable storage initially installing the device driver, such as the CD, the Internet, a network, etc., or without the user uninstalling the previously installed device driver.

Accordingly, Applicants respectfully submit that because IntelWBTA fails to teach or suggest all of the features of claim 1, the claim is allowable over IntelWBTA and withdrawal of the 102 rejection is respectfully requested. Since similar features recited by each of the independent claims 9, 12 and 21, with potentially differing scope and breadth, are not taught or disclosed by the references, the rejection should be withdrawn and claims 9, 12 and 21 allowed.

Regarding the rejection of claims 2-4, 10, 13-15 and 17-20, these claims depend directly or indirectly on one of independent claims 1, 9 or 12, and are therefore believed to be allowable for at least the reasons noted above.

REJECTION UNDER 35 U.S.C. §103:

At page 7 of the Office Action, claims 5-8, 11, and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over IntelWBTA in view of U.S. Patent Appl. Pub. No. 2002/0042911 by Harms. For at least for the reasons set forth herein, this rejection is traversed and reconsideration is respectfully requested.

Claims 5-8, 11 and 16 depend, directly or indirectly, from one of independent claims 1, 9 or 12. The rejection relies on the above rejection of independent claims 1, 9 and 12. However, as discussed above, the proposed combination of references fails to teach or suggest all of the features of the independent claims. The Applicants respectfully submit that Harms fails to make up for this deficiency.

The Applicants respectfully submit that at least because neither IntelWBTA nor Harms, individually or combined, teach or suggest all of the features of claims 5-8, 11 and 16, the proposed combination of IntelWBTA and Harms fails to establish a prima facie case of obviousness. Accordingly, claims 5-8, 11 and 16 are deemed to be allowable over the art of record. Therefore, withdrawal of the §103 rejection is respectfully requested.

NEW CLAIM:

New claim 22 is directed to at least "installing in the computer the device driver using a device driver file comprising an installation program for the device driver." Therefore, it is submitted that claim 22 patentably distinguishes over the prior art.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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